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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,740	10/28/2005	Motonori Yamamoto	280113US0PCT	1234
22850	7590	08/11/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
DEES, NIKKI H				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
08/11/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/554,740

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nikki H. Dees

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 26 January 2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on April 29, 2003. It is noted, however, that applicant has not filed a certified copy of the 103 19 315.4 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Warzelhan et al. (6,046,2483).

4. The '248 patent teaches a biodegradable polyester comprising preferably 30 to 60 mol % terephthalic acid (an aromatic dicarboxylic acid) and 40 to 70 mol % adipic acid (an aliphatic dicarboxylic acid) as well as dihydroxy compounds (col. 3 lines 34-54). Dihydroxy compounds include the aliphatic diols diethylene glycol and triethylene glycol

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(col. 4 lines 12-26). The preferred molar ratio of a) to b) as taught by the '248 patent is from 1:2.4 to 1.5:1.

5. Applicant's claim 22 is to the composition as a gum base. However, the preamble is not considered a claim limitation where the patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention. See MPEP § 2111.02 (II). In the instant application, the composition claimed as a gum base is the same as the composition as taught by the '248 patent. The teachings of the '248 patent are thus considered anticipatory of Applicant's claim 22.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warzelhan et al. (6,046,248) in view of Grijpma et al. (5,672,367).

8. The '248 patent teaches a biodegradable polyester comprising 30 to 60 mol % terephthalic acid (an aromatic dicarboxylic acid) and 40 to 70 mol % adipic acid (an aliphatic dicarboxylic acid) as well as dihydroxy compounds (col. 3 lines 34-54). Dihydroxy compounds include the aliphatic diols diethylene glycol and triethylene glycol

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(col. 4 lines 12-26). The preferred molar ratio of a) to b) as taught by the '248 patent is from 1:2.4 to 1.5:1

9. The biodegradable polymer of the '248 patent may further comprise from 0 to 5 mol %, preferably 0.05 to 4 mol % a component with at least 3 groups capable of ester formation. Examples listed include tartic acid, citric acid, malic acid and glycerol (col. 4 lines 35 to 54).

10. The '248 patent teaches that the biodegradable polymer may be made without any toxic compounds for use in the food industry (col. 5 lines 55-59).

11. Regarding claim 23, the '248 patent also teaches a method for making the polyester (col. 3 lines 34-54).

12. The '248 patent is silent as to using the biodegradable polymer in a gum base.

13. The '367 patent teaches a chewing gum base and chewing gum product comprising a biodegradable polyester having a T_g of less than 37°C in the gum base (col. 1 lines 29-42). The chewing gum further comprises sweeteners and flavors (col. 2 lines 42-67). The use of traditional chewing gum additives including oils and waxes (col. 1 lines 14-19). Further, the use of fats, waxes, resins and oils is well-known in the chewing gum art. One of ordinary skill would have found it obvious to include any one or more of these additives without undue experimentation.

14. The '367 patent additionally teaches a method for making a chewing gum product comprising mixing the gum base containing the polyester with additional traditional gum components (Examples 1 and 2).

15. Because both the '248 and '367 teach biodegradable polyesters, it would have been obvious to substitute the polyester of the '248 patent in for the polyester of the '367 patent in order to provide a chewing gum base comprising a biodegradable polyester. The substitution of one known element for another would not have required undue experimentation, and would have yielded predictable results to one of ordinary skill in the art at the time the invention was made.

16. Regarding claim 21, complying with the requirements for kosher food does not impart a structural difference to the invention and therefore cannot be relied upon to distinguish from the prior art. It is therefore considered obvious to provide the claimed invention in a kosher form if one of ordinary skill desired to market the product to the segment of the population desiring kosher products.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki H. Dees
Examiner
Art Unit 1794

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794